

REMARKS

The present amendment is in response to the Office Action dated January 7, 2004. Claims 29-33, 35-50, and 52-74 are now present in this case. Claims 29-32, 37, 38, 44, 45, 49, 50, 52-54, and 67 are currently amended. Claims 35, 46, 59-66, and 68 have been canceled. New claims 75 and 76 have been added.

The pending application is currently under appeal. The applicant hereby expressly withdraws his appeal in favor of the present request for continued examination (RCE).

The applicant wishes to draw attention to the fact that a revocation and substitute power of attorney is also filed herewith.

Claim 51 was rejected under 35 U.S.C. § 112, second paragraph. Claim 51 is canceled, thus rendering this rejection moot.

Claims 51, 60, and 67-73 stand rejected under 35 U.S.C. § 112, first paragraph. Specifically, the Office Action alleges that these claims fail to comply with the enablement requirement and allegedly include new matter. Claims 51 and 60 have been canceled. With respect to claim 67, the applicant respectfully traverses this rejection and requests reconsideration. The specification, as originally filed, provides clear support at page 19, lines 10-19 wherein the specification states "since non-compliance rates are expected to be high, an optimization based on a proposal requiring distinct efforts is likely to be rejected or ignored. On the other hand, simple changes in diet, which are likely to be adopted, may be very efficacious." Thus, the specification clearly recognizes sensitivity to the likelihood of rejection or adoption of proposals.

The specification further states that by "linking the economic model with an individual health model, the benefits of a personalized proposal at an acceptable cost is obtained." (Page 78, lines 9-23, emphasis added). Thus, the specification, at least these two cited sections, clearly provides support for the concept of "likelihood of user adoption of a selection" as recited in claim 67. Thus, the applicant respectfully submits that claim 67 is fully enabled by the specification as originally filed and does not constitute new matter. Claims 68-73 depend from claim 67 and are fully supported for

the reasons discussed above with respect to claim 67. Accordingly, the applicant respectfully requests the withdrawal of the rejection of claims 60 and 67-73 under 35 U.S.C. § 112, first paragraph.

Claims 29 – 33, 35-50, 52-59, 61-66 and 74 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,845,255 to Mayaud. Claims 35, 46, and 59-66 have been canceled thus rendering the rejection of these claims moot. With respect to the remaining claims, the applicant respectfully traverses the rejection and requests reconsideration.

Claim 29 recites *inter alia* “presenting on a computer output device, a subset of records automatically jointly optimized based on the determined economic parameters, and the statistical risk associated with the selected record.” Mayaud provides only a separate and independent output of allergy information. Even if this is an alleged to be the equivalent of risk associated with the selected record, Mayaud does not teach or suggest records jointly optimized based on determined economic parameters, and the statistical risk associated with the selected record as recited in claim 29. Indeed, even the allergy information in Mayaud is not integrated with the drug list, but remains as a separate output that is not a statistical risk associated with the selected record, as required in claim 29. Accordingly, claim 29 is clearly allowable over Mayaud. Claims 30-33, 35-43, and 74 are also allowable in view of the fact that they depend from claim 29 and further in view of the recitation in each of those claims.

Claim 44 is directed to a method and recites *inter alia* “determining a statistical risk relating to the set of records and the determined user health parameter” as well as “presenting the set of nutritional supplementation records automatically optimized based on both the determined economic parameters and the determined statistical risks.” As discussed above with respect to claim 29, Mayaud only includes an independent list of allergy information that is not associated with any particular record and does not teach or suggest determining a statistical risk relating to the set of records and the determined user health parameter, as recited in claim 44. Furthermore, nothing in Mayaud suggests presenting nutritional supplemental records automatically optimized based on both the determined economic parameters and the determined statistical risk, as recited in claim 44. Accordingly, claim 44 is clearly allowable over Mayaud. Claims

45, 47-50, and 52-58 are also allowable in view of the fact that they depend from claim 44, and further in view of the recitation in each of those claims.

Although claims 67 and 69-73 have not been examined on the merits, the applicant respectfully notes that Mayaud does not teach or suggest "automatically optimizing an economically efficient presentation of selections dependent on a joint analysis of the associated economic parameter and a risk with respect to a likelihood of user adoption of a selection" as recited in claim 67. Mayaud merely includes an independent list of allergies and does not include economic considerations and a likelihood of user adoption in optimizing a presentation of selections. Accordingly, claim 67 and dependent claims 69-73 are allowable over Mayaud.

In view of the above amendments and remarks, reconsideration of the subject application and its allowance are kindly requested. The applicant has made a good faith effort to place all claims in condition for allowance. If questions remain regarding the present application, the Examiner is invited to contact the undersigned at (206) 757-8029.

Respectfully submitted,
Andrew J. Szabo
Davis Wright Tremaine LLP

/Michael J. Donohue, Reg. #35,859/
Michael J. Donohue

MJD:mn

1201 Third Avenue
Suite 2200
Seattle, Washington 98101
Phone: (206) 757-8039
Fax: (206) 757-7029

13061709v1